

SN 09/611,548

Interview Summary

On September 5, 2012, I had a telephonic interview with Examiner Subramanian and SPE Klye who is the SPE in this case.

I submitted the attached email and exhibits to discuss, and the subject matter of the exhibits was discussed. I requested a new office action in accordance with MPEP 710.06 and a request filed June 14, 2012. The Examiner and SPE refused to issue a new office action. They maintained that the March 14, 2012 Office Action was sufficient and not erroneous. They said they look forward to my reply or pre appeal.

During the interview, I presented the arguments in my exhibit entitled "Block Quote issue exhibit" regarding §112, first paragraph, written support issues. I noted that no office action had ever made the showings required by MPEP 2163.04 and the examiner had not answered the material traversed.

The Examiners provided a new explanation for their position, a position that is not stated in their papers. I explained that from the beginning for over a year, I had not understood that this was the basis for the rejection of all this claim language under 112, first paragraph written description. I said that I thought the Office Action was rejecting all the various phrases in the block quote as unsupported. I pointed to the numerous pages 55 – 58 of the Papers filed November 28, 2011 addressing support for numerous phrases identified by the undersigned in the claims. The Examiner seemed to be saying that those phrases were supported by the specification but the computer implementation of the steps involving them was not supported by the specification. SPE Kyle agreed that that was the case with claim 197 which appears in the exhibit I submitted.

However, the Office would not commit to this new explanation of the rejection. I asked that the Office put this explanation in writing to clearly narrow issues for appeal. They refused. I pointed out that the Examiner had not addressed my arguments on those pages regarding the particular claim phrases. I pointed out that the March 14, 2012 Office Action had not addressed my arguments regarding those phrases in violation of MPEP 707.07(f) and MPEP 2163.04. They refused to give me any further writing explaining this position.

We discussed the "true lease" claim language issue of support under 112, first paragraph, for written description. I explained that the specification says a "tax lease" with reference to the paragraph of the specification and the dictionary definition submitted says a true lease is also a tax lease, so the claim language is supported.

The Examiner suggested amending the claim language to "tax lease" since that is in the specification.

SPE Kyle said that I should make claim charts with the rejected claim on one side and the citation to the specification across from it. He said that Quality Control expects this. I said I had already identified paragraphs in the specification for support with argument and all the Office did was say "The examiner disagrees" without addressing my arguments. I said the Office is supposed to address my arguments.

/Donna L. Angotti/
Reg. No. 32,679
September 5, 2012

From: email@angottilaw.com
Subject: Fwd: SN 09/611,548 Telephone conference
Date: 09/04/2012 01:14 PM
To: Charles.Kyle@USPTO.gov, Narayanswamy.Subramanian@USPTO.gov
Attachments: 710.06 exhibit 8.28.12.pdf(372.9 KB), Block Quote issue exhibit.pdf(239.6 KB), 112 first para true lease issue.pdf(637.4 KB)

Dear Sirs:

I am resending this re our telephone conference for 3:00 Wed. September 5, 2012 for easy reference.

Best regards,
Donna

The Law Offices of
Donna L. Angotti
140 Broadway
Suite 4600
New York, NY 10005
Tel.: (212) 858-7515

-----Original Message-----

From: "email@angottilaw.com" [email@angottilaw.com]
Date: 08/28/2012 04:12 PM
To: charles.kyle@USPTO.gov, n.subramanian@USPTO.gov
Subject: SN 09/611,548 Telephone conference

Dear Sirs:

I look forward to our telephone conference at 3:00 pm August 29, 2012.

I wish to discuss the papers filed June 14, 2012, including the definitions of "true lease" quoted therein, and the attached exhibits which we can go through during the call.

Pertinent sections of the MPEP are 710.06 (copy attached);
2163.04; and
707.07(f).

The issues involve the written description rejections under 35 U.S.C. 112, first paragraph. I have divided them into (1) the block quote issue (which I would like to address first), and (2) the "true lease" issue.

Best regards,
Donna

The Law Offices of
Donna L. Angotti
140 Broadway
Suite 4600
New York, NY 10005
Tel.: (212) 858-7515

Applicant's Paper of 6/14/2012

Requested Complete new Office Action be Mailed On grounds of Block Quote §112, Paragraph 1 Issue

710.06 Situations When Reply Period Is Reset or Restarted [R-6]

Where the citation of a reference is incorrect or an Office action contains some other error that affects applicant's ability to reply to the Office action and this error is called to the attention of the Office within 1 month of the mail date of the action, the Office will restart the previously set period for reply to run from the date the error is corrected, if requested to do so by applicant. If the error is brought to the attention of the Office within the period for reply set in the Office action but more than 1 month after the date of the Office action, the Office will set a new period for reply, if requested to do so by the applicant, to substantially equal the time remaining in the reply period. For example, if the error is brought to the attention of the Office 5 weeks after mailing the action, then the Office would set a new 2-month period for reply. The new period for reply must be at least 1 month and would run from the date the error is corrected. See MPEP § 707.05(g) for the manner of correcting the record where there has been an erroneous citation.

Where for any reason it becomes necessary to re-mail any action (MPEP § 707.13), the action should be correspondingly redated, as it is the remailing date that establishes the beginning of the period for reply. **For Image File Wrapper (IFW) processing, see IFW Manual.

A supplementary action after a rejection explaining the references more explicitly or giving the reasons more fully, even though no further references are

cited, establishes a new date from which the statutory period runs.

If the error in citation or other defective Office action is called to the attention of the Office after the expiration of the period for reply, the period will not be restarted and any appropriate extension fee will be required to render a reply timely. The Office letter correcting the error will note that the time period for reply remains as set forth in the previous Office action.

§112, Paragraph 1

Issue: "True Lease" Claim Language

**Applicant's Statement of Support in Specification in
Amendment of 11/3/2010, pg 47.**

- **Cites paragraphs of Specification**

REMARKS/ARGUMENTS

Claims 1-205 are now pending. Claims 1, 2, 28, 31, 53, 56, 60, 74, 93, 102, 119, 130, 133, 140, 148, 154, 158, 161, 172, 181, 182, 183, 193 and 197 are independent. Claims 182 to 201 are added in this amendment, to address the PTO's new interpretations of § 101 in the *Bilski* Guidelines and recent decisions of the Board of Patent Appeals and Interferences. A check for \$1064.00 to cover the additional four independent claims and for 24 additional claims over 20 is enclosed.

By this paper, Applicant amends the claims to address the PTO's new interpretations of § 101 in the *Bilski* Guidelines and recent decisions of the Board of Patent Appeals and Interferences.

The language "with assistance of a computer" has been amended.

Claims have been amended to recite "an operating lease under financial accounting rules or a true lease under tax accounting rules". This language is supported at, for example, paragraphs [0018], [0021], [0029], [0072], and [0082] (paragraph number references are to the Substitute Specification filed September 29, 2005).

The "segregable payments" of new claims 183-203 are supported at, for example, Figs. 2A and 2B.

The added claims are patentable for reasons discussed in the papers of November 2009 and August 2010.

This paper incorporates by reference the paper of November 5, 2009 captioned "Reply to Office Action or in the Alternative Appeal Brief" and in the Reply to Office Action of August 19, 2010. Applicant reiterates the cautions of examination procedure set forth in those two papers:

- Breadth is not indefiniteness. MPEP § 2174
- Alternative language is not indefinite *per se*. MPEP § 2173.05(h)(II); *In re Gaubert*, 524 F.2d 1222, 187 USPQ 664 (CCPA 1975).
- There is no such thing as a "descriptive matter" exclusion applicable to § 102/§ 103. There is no mention of such a thing in MPEP Chapter 2100.¹ Only "printed matter"

¹ MPEP § 2106.01 discusses "descriptive material" but only in the context of § 101.

**Examples of Rejections under
§112, Paragraph 1 for “True Lease” Claim Language
From Non-final Office Action dated 5/26/2011
(pgs. 3, 10-11).**

- Fails to meet MPEP §2163.04 for a §112, Paragraph 1 Rejection
- Ignores paragraphs of specification cited by Applicant
- Examiner’s Response to Arguments States Applicant’s Arguments are moot (pg. 23).

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4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to support the subject matter set forth in the claims. The specification, as originally filed does not provide support for the invention as now claimed.

The test to be applied under the written description portion of 35 U.S.C. § 112, first paragraph, is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of later claimed subject matter. Vas-Cat, Inc. v. Mahurkar, 935 F. 2d 1555, 1565, 19 USPQ2d 111, 1118 (Fed. Cir. 1991), reh'g denied (Fed. Cir. July 8, 1991) and reh'g, en banc, denied (Fed. Cir. July 29, 1991).

Claims 1 and 2 recite the limitations “a true lease under tax accounting rules” and “at least some portion of the improvements lease being or having been performed by processing data in a non-transitory memory of a computer” (emphases added).

Claims 28, 35, 57, 95, 114, 120, 122, 143, 170, 175 and 198 recite the limitation “a true lease under tax accounting rules” (emphasis added).

Claim 31 and 102 recites the limitation “at least some portion of the improvements lease being or having been performed by processing data in a non-transitory memory of a computer” (emphasis added).

Claim 56 recites the limitation “at least some portion of the lease being or having been performed by processing data in a non-transitory memory of a computer” (emphasis added).

Claim 197 recites the limitations "processing data in a non-transitory memory of a computer, the processing reflecting paying or receiving a payment on a lease granting rights to use tenant improvements to a tenant, the tenant improvements being improvements to a space leased to the tenant, financing or ownership of the tenant improvements being distinct from financing or ownership of the space, an amount of the payment payable to a tenant improvements payee for lease of the tenant improvements being segregable from an amount payable to a distinct space payee for lease of the space, the segregation reflecting the distinct ownership or financing; financing for the tenant improvements being provided by an entity other than a tenant of the space, financing for the tenant improvements being obtained at the tenant's cost of funds; the processed data representing at least one of a group consisting of (a) the lessor of the space, (b) the lessor of the tenant improvements, (c) the tenant, and (d) a primary investor, secondary investor, or lender, who contributed capital to the improvements or to an entity owing the improvements" (emphasis added).

However, the original specification does not provide a written description disclosure to support the claimed limitations identified above especially the emphasized portions of the limitations.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 1-52 and 56-205 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which

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was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In particular, claims 1, 2, 28, 31, 56, 60, 74, 93, 102, 119, 130, 133, 140, 148, 154, 158, 161, 172, 181, 182, 183, 193 and 197 are rejected under 35 U.S.C. § 112, first paragraph, because the specification does not provide a written description disclosure to support the claimed limitations as discussed in the objections to specification above. Similar reasoning and logic apply to the dependent claims. Dependent claims are also rejected by way of dependency on a rejected independent claim.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

9. Claims 1-27, 31-52, and 56-181 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Independent claims 1, 2, 31, 74, 102, 130, 133, 140, 154, 161, and 179 recite the limitation "at least some portion of the improvements lease being or having been performed by processing data in a non-transitory memory of a computer". Independent claims 56, 93, 119, 158, and 172 recite the limitation "at least some portion of the lease being or having been performed by processing data in a non-transitory memory of a computer". Also independent claims 60 and 148 recite the limitation "at least some portion of leasing the shorter-lived asset being or having been performed by processing data in a non-transitory memory of a computer". Similarly independent claim 180 recites the limitation "at least some portion of soliciting, originating, managing, or analyzing the improvements lease being or having been performed by processing

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need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. *See In re Lowry*, 32 F.3d 1579, 1583-84 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 1338 (Fed. Cir. 2004). As discussed above there is no new and unobvious functional relationship between the descriptive material and the substrate.

Claims 198-203, the limitations in these claims are interpreted as non-functional descriptive data that describe the underlying contract, the payment being processed and the data being stored. As discussed above these are interpreted as non-functional descriptive data that describe the underlying contract and the data being stored. The non-functional descriptive data does not materially affect the features of processing the payment and storing data. The examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. *See In re Lowry*, 32 F.3d 1579, 1583-84 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 1338 (Fed. Cir. 2004). As discussed above there is no new and unobvious functional relationship between the descriptive material and the substrate.

Response to Arguments

14. Applicant's arguments with respect to pending claims have been considered but are moot in view of new grounds of rejection.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure are listed on the enclosed PTO-892.

**Example of Applicant's Response from 11/28/2011
Papers (pgs. 52-53).**

- Identifies "true lease" claim language
- Identifies claims with that language
- Arguments for support in Specification
- Cites specification and quotes paragraph [0072] of
Specification

as a pdf file through the PTO's Electronic Business Center. Apparently substitute specifications and drawings and requests for republication do not appear in PAIR.

In July 2000, when this application was filed, MPEP § 608.01(b) read as follows:

The abstract should be in narrative form and generally limited to a single paragraph within the range of 50 to 250 words. The abstract should not exceed 25 lines of text.

The Abstract meets the guidelines that were in effect at the time. The severely belated objection should be withdrawn. Nonetheless, to accommodate Examiner Subramanian's personal, but inapplicable, preferences, an amended abstract is submitted herewith.

C. Specification

The specification is objected to under 35 U.S.C. §112, first paragraph, as failing to support the subject matter set forth in the claims.

1. "true lease"

The claim language found unsupported is essentially the limitation "a true lease under tax accounting rules" which was added by the amendment of November 3, 2010. That paper said on page 47:

Claims have been amended to recite "an operating lease under financial accounting rules or a true lease under tax accounting rules". This language is supported at, for example, paragraphs [0018], [0021], [0029], [0072], and [0082] (paragraph number references are to the Substitute Specification filed September 29, 2005).

The language of paragraph [0072] of the specification referenced reads as follows (original specification of July 2000, page 15 line 30 to page 16, line 3):

.... In contrast, lease 100 may be structured so that the lease of tenant improvements from special purpose entity 110 to tenant 102 meets Internal Revenue Code standards for a tax lease; this will render the rent 124 paid from tenant 102 to special purpose entity 110 deductible as an ordinary business expense. This may convert the deduction schedule from thirty-nine years to depreciate the tenant improvements (when tenant 102 is the tax owner of the tenant improvements) into a shorter schedule based on the term 122 of lease 100.

The Office Action does not reflect that any consideration was given to this language which clearly states a "tax lease," i.e. a true lease under tax accounting rules as mentioned.

The Office Action provides no analysis of why the Patent Office takes the position that the cited paragraphs fail to provide support for the claim language. Such failure does not advance prosecution.

With respect to a "written description" issue, MPEP § 2163(III)(A) and § 2163.04 required that the Action "Establish a *prima facie* case by providing reasons why a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the invention as claimed." The Action did not do so. Until the rejection in the Action is clear, Applicant is left without a fair opportunity to respond.

Because the Office Action does not make the showings required for the "written description" requirement, disregards the MPEP, disregards Applicant's previous paper, and disregards the specification, it is not clear what the issue is, and therefore it is impossible to respond more precisely. Thus, the objection is improper. The language is supported as set forth above. This argument applies to claims 1, 2, 28, 35, 57, 95, 120, 122, 143, 170, 175, 198, 60, 133, 148, 179, 180, 181, 183, and 193.

2. "at least some portion of the lease being or having been performed by processing data in a non-transitory memory of a computer" and "non-transitory memory"

Additional claim language found unsupported is essentially the limitation "at least some portion of the lease being or having been performed by processing data in a non-transitory memory of a computer." This language was previously amended from "at least some portion of the lease being or having been performed with assistance of a computer processing data in a tangible memory of a computer." With the present amendment the language has been deleted and instead the claims recite "computing data in a non-transitory memory of a computer, the computation in furtherance of an improvements lease, the improvements lease being a lease of improvements" (for Claim 2) or similar language. It is believed the amended language overcomes any indefiniteness. The support for the language is the same as for the previous language.

The issue of support in the specification for the previous language was fully addressed previously in the Amendment and Reply to Office Action or in the Alternative Appeal Brief filed November 5, 2009 at pages 20-21:

**Final Office Action of 3/14/2012 repeats §112,
Paragraph 1 rejection – quotes more claim language as
unsupported in claims 1 and 2**

**Examiner Response to Arguments in Final Office
Action of 3/14/2012 (paragraph 13 at pg. 26).**

- **Examiner disagrees**
 - **Examiner adds “There is no support in the
paragraphs cited above for the limitation....”**
 - **No reason given**
-

- Fails to meet MPEP §2163.04 for a §112, Paragraph 1
Rejection
- Fails to address all material traversed, MPEP §707.07(f)
- If paragraph 13, pg. 26 is an explanation; it is a new
argument and explanation, and a new grounds of
rejection.
- Thus, finality should be withdrawn

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there is no new and unobvious functional relationship between the descriptive material and the substrate.

Claims 198-203, the limitations in these claims are interpreted as non-functional descriptive data that describe the underlying contract, the payment being processed and the data being stored. As discussed above these are interpreted as non-functional descriptive data that describe the underlying contract and the data being stored. The non-functional descriptive data does not materially affect the features of processing the payment and storing data. The examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. *See In re Lowry*, 32 F.3d 1579, 1583-84 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 1338 (Fed. Cir. 2004). As discussed above there is no new and unobvious functional relationship between the descriptive material and the substrate.

Response to Arguments

13. In response to Applicant's assertion "Claims have been amended to recite "an operating lease under financial accounting rules or a true lease under tax accounting rules". This language is supported at, for example, paragraphs [0018], [0021], [0029], [0072], and [0082] (paragraph number references are to the Substitute Specification filed September 29, 2005)", the Examiner respectfully disagrees. There is no support in the paragraphs cited above for the limitation "a true lease under tax accounting rules". Hence rejections under 112, first paragraph are maintained for claims 1, 2, 28, 35, 57, 95, 120, 122, 143, 170, 175, 198, 60, 133, 148, 179, 180, 181, 183, and 193.

Applicant's Paper of 6/14/2012

**Requested Complete new Office Action be Mailed
On "True Lease" §112, Paragraph 1**

Requested Finality be Withdrawn

Applicant provides dictionary definitions

Advisory Action of 7/20/2012

- **The Examiner disagrees**
 - **Examiner cites to prior Office Actions**
 - **Examiner tells Applicant to read prior Office Action**
 - **No substantive answers**
 - **No explanation of why cited paragraphs of specification do not support claim language especially in view of dictionary definitions**
-

- Still Fails to meet MPEP §2163.04 for a §112, Paragraph 1 Rejection
- Still Fails to address all material traversed, MPEP §707.07(f)
- Finality still improper
- Applicant can not even narrow issues for appeal by eliminating §112, Paragraph 1 issues

Continuation of 11. does NOT place the application in condition for allowance because: of the following reasons. In response to Applicant's assertion "The Action must be remailed because of multiple omissions relating to the claim language "true lease for tax purposes" that affect Applicant's ability to reply and Finality should be withdrawn", the Examiner respectfully disagrees. There is no support for the limitation "a true lease under tax accounting rules" in the specification as originally filed. This was explained by the Examiner in the Non-Final action mailed on May 26, 2011 and again in the Final Office action mailed on March 14, 2012. In response to Applicant's assertion "The "written description issues" are not stated in the manner required by the MPEP, and thus no direct reply is possible", the Examiner respectfully disagrees. The written description issues are discussed in paragraphs 2-5, in pages 2-12 of the Final Office action mailed on March 14, 2012. Applicant should read the entire contents of Paragraphs 2-5 of the Final Office action before reaching conclusions. In response to Applicant's assertion "Applicant urges paragraph numbering as suggested by MPEP § 707.07(k) The Examiner's attention is drawn to MPEP § 707.07(k): 707.07(k) Numbering Paragraphs: It is good practice to number the paragraphs of the Office action consecutively. This facilitates their identification in the future prosecution of the application.", the Examiner would like to point out that the paragraphs have been numbered consecutively as suggested by the MPEP. Each form paragraph used in the rejection has been numbered in the order in which they appear in the Office action. Applicant's other arguments have been considered but are not persuasive. For these reasons and the reasons discussed in the Final office action, the Finality of the rejections are maintained by the Examiner.

§112, Paragraph 1

Issue: Block Quotes of Claim Language

**Example of Block Quote Rejection under
§112, Paragraph 1 for Claim 197
From Non-final Office Action dated 5/26/2011**

(11 years after case was filed)

(There are 9 pages of Block Quote rejections under §112, Paragraph 1) (pgs. 3-9).

- Fails to meet MPEP §2163.04 for a §112, Paragraph 1
Rejection

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Claim 197 recites the limitations "processing data in a non-transitory memory of a computer, the processing reflecting paying or receiving a payment on a lease granting rights to use tenant improvements to a tenant, the tenant improvements being improvements to a space leased to the tenant, financing or ownership of the tenant improvements being distinct from financing or ownership of the space, an amount of the payment payable to a tenant improvements payee for lease of the tenant improvements being segregable from an amount payable to a distinct space payee for lease of the space, the segregation reflecting the distinct ownership or financing; financing for the tenant improvements being provided by an entity other than a tenant of the space, financing for the tenant improvements being obtained at the tenant's cost of funds; the processed data representing at least one of a group consisting of (a) the lessor of the space, (b) the lessor of the tenant improvements, (c) the tenant, and (d) a primary investor, secondary investor, or lender, who contributed capital to the improvements or to an entity owing the improvements" (emphasis added).

However, the original specification does not provide a written description disclosure to support the claimed limitations identified above especially the emphasized portions of the limitations.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 1-52 and 56-205 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which

was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In particular, claims 1, 2, 28, 31, 56, 60, 74, 93, 102, 119, 130, 133, 140, 148, 154, 158, 161, 172, 181, 182, 183, 193 and 197 are rejected under 35 U.S.C. § 112, first paragraph, because the specification does not provide a written description disclosure to support the claimed limitations as discussed in the objections to specification above. Similar reasoning and logic apply to the dependent claims. Dependent claims are also rejected by way of dependency on a rejected independent claim.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

9. Claims 1-27, 31-52, and 56-181 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Independent claims 1, 2, 31, 74, 102, 130, 133, 140, 154, 161, and 179 recite the limitation "at least some portion of the improvements lease being or having been performed by processing data in a non-transitory memory of a computer". Independent claims 56, 93, 119, 158, and 172 recite the limitation "at least some portion of the lease being or having been performed by processing data in a non-transitory memory of a computer". Also independent claims 60 and 148 recite the limitation "at least some portion of leasing the shorter-lived asset being or having been performed by processing data in a non-transitory memory of a computer". Similarly independent claim 180 recites the limitation "at least some portion of soliciting, originating, managing, or analyzing the improvements lease being or having been performed by processing

Example of Applicant's Response from 11/28/2011 Papers

- Identifies particular claim language
- Identifies claims with that language
- Arguments for support in Specification

(There are 7 pages of response) (pgs. 52-59).

claims 1, 2, 31, 102, 56, 60, 74, 93, 119, 126, 127, 128, 129, 130, 133, 140, 148, 154, 158, 161, 172, 179, 180, 181, 182, 183, 193 and 197 (taken in the order of the Office Action).

The law regarding written support simply requires that the specification conveys to one of ordinary skill that the inventor had possession of the subject matter. It does not require the specification to recite the claim language verbatim.

3. "a primary investor, secondary investor, or lender, who contributed capital to the asset or to an entity owning the asset"

The Action questions "support" under the "written description" requirement for the language "a primary investor, secondary investor, or lender, who contributed capital to the asset or to an entity owning the asset." The language regarding a primary investor and a secondary investor has been changed to "investor(s)". This language is supported by the specification as originally filed at least by Figs. 2A and 2B which show numerous investors.

This language "lender, who contributed capital to the asset or to an entity owning the asset" is supported as follows:

Fig. 2C shows lenders. The specification at paragraph [0087] and after (publication paragraph nos.) discloses a computer implementation of the lease structure of Fig. 1. Fig. 2C shows Data Warehouse 500 and Loan Analysis Module 510 which are discussed at paragraphs [0111] and after. Fig. 4A shows a computer screen with numerous loans giving landlords, tenants, lease amount etc. Paragraph [0121] states, "By simply double clicking on an individual loan, the user can retrieve additional background and performance data on a specific loan." One of ordinary skill in the art would understand that the additional background includes the information shown in Fig. 1 for the lease structure and identities of parties. Fig. 1A at the bottom under Capitalization reference is made to the percentage of participation.

- "lender" -- Fig. 3C shows financing institutions and Polestar.
- "who contributed capital to the asset" -- inherent in disclosure at bottom of Fig. 1A where lessor is identified at least.
- "who contributed capital ... to an entity owning the asset" -- inherent in capitalization participation of lessor.

This applies to claims 119, 130, 133, 183, and 197. The language is supported.

**Final Office Action of 3/14/2012 repeats §112,
Paragraph 1 rejections verbatim – nothing new added**

**Examiner Response to Arguments in Final Office
Action of 3/14/2012 (pgs. 26-27).**

- **Examiner does not even address the arguments or**
 - **Examiner disagrees**
 - **No reason given**
-

- Fails to meet MPEP §2163.04 for a §112, Paragraph 1
Rejection
- Fails to address all material traversed, MPEP §707.07(f)

there is no new and unobvious functional relationship between the descriptive material and the substrate.

Claims 198-203, the limitations in these claims are interpreted as non-functional descriptive data that describe the underlying contract, the payment being processed and the data being stored. As discussed above these are interpreted as non-functional descriptive data that describe the underlying contract and the data being stored. The non-functional descriptive data does not materially affect the features of processing the payment and storing data. The examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. *See In re Lowry*, 32 F.3d 1579, 1583-84 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 1338 (Fed. Cir. 2004). As discussed above there is no new and unobvious functional relationship between the descriptive material and the substrate.

Response to Arguments

13. In response to Applicant's assertion "Claims have been amended to recite "an operating lease under financial accounting rules or a true lease under tax accounting rules". This language is supported at, for example, paragraphs [0018], [0021], [0029], [0072], and [0082] (paragraph number references are to the Substitute Specification filed September 29, 2005)", the Examiner respectfully disagrees. There is no support in the paragraphs cited above for the limitation "a true lease under tax accounting rules". Hence rejections under 112, first paragraph are maintained for claims 1, 2, 28, 35, 57, 95, 120, 122, 143, 170, 175, 198, 60, 133, 148, 179, 180, 181, 183, and 193.

In response to Applicant's assertion that the specification provides support for the claim language of "computing data in a non-transitory memory of a computer, the computation in furtherance of an improvements lease, the improvements lease being a lease of improvements" (for Claim 2) or similar language", the Examiner respectfully disagrees. The Examiner is unable to find support for such limitations in the original specification as discussed in the rejections under 112, first paragraph for claims having similar language. Hence the rejections under 112, first paragraph for claims having similar language are maintained.

In response to Applicant's assertion that the specification provides support for the claim language of claims 181 and 182, the Examiner respectfully disagrees. The Examiner is unable to find support for limitations in these claims in the original specification (and particularly in paragraph 87 or Figure 2C of the original specification) as discussed in the rejections under 112, first paragraph. Figure 2C refers to computer software. However the structures of a computer system claimed in claims 181 and 182 are not adequately disclosed in Figure 2C and/or paragraph 87 of the original specification. Hence the rejections under 112, first paragraph for claims 181 and 182 are maintained.

In response to Applicant's assertion "Claim 181 meets the requirements of Section 112, 2nd paragraph and is definite", the Examiner respectfully disagrees. In view of the ambiguities identified in the claim the scope of the claim is indefinite. Hence the rejection under 35 USC 112, 2nd paragraph is maintained.

In response to Applicant's assertion "The claims each recite methods, and specify that some part of the method requires processing or computing by a computer. A computer is indisputably a "machine." Processing or computing in a machine is not "abstract." The claims

Applicant's Paper of 6/14/2012

**Requested Complete new Office Action be Mailed
On grounds of Block Quote §112, Paragraph 1 Issue**

Advisory Action of 7/20/2012

- **The Examiner disagrees**
 - **Examiner cites to prior Office Actions**
 - **Examiner tells Applicant to read prior Office Action**
 - **No substantive answers**
-

- Still Fails to meet MPEP §2163.04 for a §112, Paragraph 1 Rejection
- Still Fails to address all material traversed, MPEP §707.07(f)

Continuation of 11, does NOT place the application in condition for allowance because: of the following reasons. In response to Applicant's assertion "The Action must be remailed because of multiple omissions relating to the claim language "true lease for tax purposes" that affect Applicant's ability to reply and Finality should be withdrawn", the Examiner respectfully disagrees. There is no support for the limitation "a true lease under tax accounting rules" in the specification as originally filed. This was explained by the Examiner in the Non-Final action mailed on May 26, 2011 and again in the Final Office action mailed on March 14, 2012. In response to Applicant's assertion "The "written description issues" are not stated in the manner required by the MPEP, and thus no direct reply is possible", the Examiner respectfully disagrees. The written description issues are discussed in paragraphs 2-5, in pages 2-12 of the Final Office action mailed on March 14, 2012. Applicant should read the entire contents of Paragraphs 2-5 of the Final Office action before reaching conclusions. In response to Applicant's assertion "Applicant urges paragraph numbering as suggested by MPEP § 707.07(k) The Examiner's attention is drawn to MPEP § 707.07(k): 707.07(k) Numbering Paragraphs: It is good practice to number the paragraphs of the Office action consecutively. This facilitates their identification in the future prosecution of the application.", the Examiner would like to point out that the paragraphs have been numbered consecutively as suggested by the MPEP. Each form paragraph used in the rejection has been numbered in the order in which they appear in the Office action. Applicant's other arguments have been considered but are not persuasive. For these reasons and the reasons discussed in the Final office action, the Finality of the rejections are maintained by the Examiner.